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| 09/669,594 | 09/26/2000 | Prasad Raje | 004426.P001 | 5001 |
| 8791 | 7590 | 04/01/2009 | | |
| BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040 | | | EXAMINER | |
| | | | BASEHOAR, ADAM L | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|-------------------------------------|
| Office Action Summary | Application No. 09/669,594 | Applicant(s) RAJE, PRASAD |
| | Examiner ADAM L. BASEHOAR | Art Unit 2178 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 14 January 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 126-129,131-140,142 and 144-154 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 126-129,131-140,142 and 144-154 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/898)
 Paper No(s)/Mail Date 01/14/09.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Inventory of Patent Application
 6) Other: _____

DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 01/14/09.
2. Claim 143 has been cancelled as necessitated by the Amendment.
3. All previous rejections the claims have been withdrawn as necessitated by Amendment.
4. Claims 126-129, 131-140, 142, 144-154 are pending. Claims 126, 132, 137, 143 are independent claims.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 01/14/09 has been considered by the examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 126-127, 129, 131-134, 136-138, 140, 142, 144-146, and 148-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm User's Manual (hereinafter OmniForm), Caere Corporation, released March 22, 1999 (as evidenced by cited PR NewsWire article), pages 1-108, 173-199, in view of Larson (US-6,088,700 07/11/00) in further view of Strong et al (US-6,167,523 12/26/00).

In regard to independent claim 126, OmniForm teaches a form design application for designing, and editing an electronic form (OmniForm pages 25-43). OmniForm teaches opening a form, as well as e-mailing an electronic form using Outlook (OmniForm page 39-43). Since OmniForm can reopen any form in OmniForm format (see OmniForm page 15), OmniForm can also receive an already created electronic form via email (typically including input fields). It is noted that an OmniForm form is written in a form authoring language. (compare with "*A method comprising: receiving, through a network, a form authored using a form authoring language, the form containing one or more input fields;*"").

OmniForm teaches opening a form for redesigning, etc. (OmniForm page 15). In doing so, OmniForm reads and analyzes the underlying constructs of said form (which typically includes parsing the code) so as to create and/or re-create active input fields (compare with "*parsing the received form to identify the input fields contained in the received form;*"").

OmniForm teaches a graphical user interface dependent upon (associated with) the form's input fields (OmniForm at least page 32), as well as the capability of opening a form file (e.g. a specific form submission) emailed from another user (a third party). OmniForm further teaches allowing identification of actions to be associated with the identified input fields upon submission of instance of a form by a third party and automatically generating a program code to carry out the actions associated with the identified input fields, wherein no modifications to the input fields of the form are made by the generation of the program code (Page 73: "set validation options"; Pages 76-77: "set validation options for fill text objects": i.e. OmniForm teaches wherein via a graphical user interface a form creator/editor can assign validation actions to specific input form fields, whereupon the validation actions are assigned, program code for

carrying out said validation is generated/applied to said fields with further use of the forms via third parties requiring said validation actions to be taken on the data input into said input fields via said third parties).

OmniForm generally teaches the creation of forms for eventual third party interaction/submission (Page 15: "Work on a Form's Design" & "Create a New, Blank Form"; Page 77: e.g. "Allow user to override validation...force the user to enter data in the selected field...override the warning"), receiving data from a third party (Page 77: "user enter data in the selected field"), and executing program code on said data in view of said input fields (Page 77: "display a prompt in fill view if the user enters incorrect information in the field"). OmniForm does not specifically teach receiving a specific submission/instance of a data filled in form from a third party and carry out the actions associated with the identified input fields. Larsen et al teach receiving a specific submission of a data filled in form from a third party and carry out the actions associated with the identified input fields (column 2, lines 23-38: "the fully completed forms are then transmitted to the parties requesting the information"; column 3, lines 1-12: "tool validates that all required information has been entered and that the fields that require specific format are correct" & 20-67; column 4, lines 1-50). It would have been obvious to one of ordinary skill in the art at the time of the invention for the OmniForm to have received a specific form submission with filled in form data and validated/processed it as shown in Larsen, because Larsen taught that automatic processing third party form submissions provided a convenient method for filling out and processing forms by eliminating incomplete and incorrect information associated with filling out forms (column 2, lines 5-10 & 63-67: "convenient method....eliminate incomplete and incorrect information").

Neither OmniForm nor Larsen specifically teach wherein the generated program code for carrying out actions associated with the identified fields (Page 73: "set validation options"; Pages 76-77: "set validation options for fill text objects": i.e. OmniForm teaches wherein via a graphical user interface a form creator/editor can assign validation actions to specific input form fields, whereupon the validation actions are assigned, program code for carrying out said validation is generated/applied to said fields with further use of the forms via third parties requiring said validation actions to be taken on the data input into said input fields via said third parties) was "external to the form." Strong et al teaches associating program code to carry out actions associated with identified input fields of an HTML form external to the form (i.e. the program code is located external to the form on the server)(column 1, lines 46-67; column 2, lines 10-15; column 3, lines 11-32; column 4, lines 62-67; column 5, lines 1-12 & 39-45; column 6, lines 31-42; column 10, lines 58-67; column 11, lines 1-5)(Figs. 2, 4, 5). It would have been obvious to one of ordinary skill in the art at the time of the invention for the program validation code generated/applied in OmniForm to have been stored external to the form, because Strong taught when data validation and processing information was included in the HTML form, HTML form design could become cumbersome and time-consuming (column 2, lines 10-15: "create unnecessary security risk...cumbersome and time-consuming"). Strong further taught that by storing the generated code for validating and processing the HTML form external from the form, the user and/or developer of form gained the additional benefits of reduced development time and effort (column 3, lines 12-15), operating efficiently in many different environments (column 5, lines 41-45), as well as easy providing easy customizable validation and processing support (column 10, lines 58-67; column 11, lines 1-5).

In regard to dependent claim 127, OmniForm teaches conversion of a form to HTML (OmniForm page 46-47).

In regard to dependent claim 129, OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55).

In regard to dependent claim 131, OmniForm teaches validation options for automatically validating input (OmniForm pages 76-77). If input does not validate, the user is notified accordingly.

In regard to independent claim 132, claim 132 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 126, and is rejected along the same rationale.

In regard to dependent claim 133, OmniForm teaches a computer, typically incorporating a processor(s) (OmniForm page 8).

In regard to dependent claims 134, 136, claims 134, 136 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 127, 131 respectively, and are rejected along the same rationale.

In regard to claims 137-138, 140, and 142, claims 137-138, 140 and 142 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 126-127, 129-131 respectively, and are rejected along the same rationale.

In regard to dependent claim 144, OmniForm teaches validation options for automatically validating input (OmniForm pages 76-77). If input does not validate, the user is notified accordingly.

In regard to dependent claim 145, OmniForm teaches generating necessary quantities of associations as per input fields (OmniForm at least page 32; e.g. Order Form).

In regard to dependent claim 146, OmniForm teaches licensing (OmniForms page 48).

In regard to dependent claims 148-149, OmniForm teaches e-mailing a form, and using a routing slip (OmniForm page 40-43).

In regard to dependent claims 150-151, OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55). OmniForm teaches receiving a form in a design phase, including both the form and data (OmniForm page 41).

In regard to dependent claims 152-154, OmniForm teaches management of database records (including data) in a database (typically comprising inclusion of records in various rows of a table (see OmniForm Chapter 7, page 173-199).

8. Claims 128, 135, 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm, in view of Larson (US-6,088,700 07/11/00), in further view of Strong et al (US-6,167,523 12/26/00) in further view of PR NewsWire article (hereinafter PR NewsWire), March 22, 1999, ProQuest Direct, pages 1-5.

In regard to dependent claim 128, 135, 139, OmniForm does not specifically teach utilizing CGI. However, PR NewsWire teaches instructions for integrating CGI into forms (PR NewsWire page 4 item b). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply PR NewsWire to OmniForm, providing OmniForm the benefit of adding CGI scripting for collecting form data

9. Claims 147 is rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm, view of Larson (US-6,088,700 07/11/00) in further view of Strong et al (US-6,167,523 12/26/00) in further view of Davis et al. (hereinafter Davis) U.S. Patent No. 5,796,952 issued 8/1998.

In regard to dependent claim 147, OmniForm does not specifically teach cookies.

However, Davis teaches cookies (Davis column 11 lines 13-33, column 18 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Davis to OmniForm, providing OmniForm the benefit of cookies for tracking users/data.

Response to Arguments

10. Applicant's arguments with respect to the independent claims have been considered but are moot in view of the new ground(s) of rejection.

-The Applicant argues that OmniForm does not specifically teach wherein the generated program code is external to the form. The Examiner notes that the newly applied Strong et al reference has been relied upon to teach said feature with HTML forms as well as its well known benefits.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM L. BASEHOAR whose telephone number is (571)272-4121. The examiner can normally be reached on M-F: 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam L Baschoar/
Primary Examiner, Art Unit 2178